



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,116	01/26/2001	Howard Benjamin	PPI-012CN	9135
959	7590	07/13/2004	EXAMINER	
LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109			PONNALURI, PADMASHRI	
			ART UNIT	PAPER NUMBER
			1639	
DATE MAILED: 07/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/772,116

Applicant(s)

BENJAMIN ET AL.

Examiner

Padmashri Ponnaluri

Art Unit

1639

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 28 May 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-7 and 10-23.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


PADMASHRI PONNALURI
PRIMARY EXAMINER

Padmashri Ponnaluri
Primary Examiner
Art Unit: 1639

Continuation of 2. NOTE: The proposed amendment adds the limitation 'family of peptides that bind', which may raise new matter rejection and the term is indefinite and further raise new rejections under 35 USC. 112 first and second paragraphs.

Continuation of 3. Applicant's reply has overcome the following rejection(s): The proposed amendment would overcome the written description rejection and 112, second paragraph rejections of record.

Continuation of 5. does NOT place the application in condition for allowance because: The rejections of record over Baindur (US Patent 5,891,737) have been maintained for the reasons of record. Applicants argue that Baindur et al teach the first library that leads to the identified lead peptide is composed of heterochiral amino acids, all D-amino acids and non-proteinogenic amino acids, and the instant invention first library is composed of peptides. Applicants arguments have been considered and are not persuasive, because applicants are referring to the reference non-peptide library to the first library as in the instant claims, the non-peptide library of the reference reads on the second library of the instant claims. Applicants arguments have been considered and are not persuasive for the following reasons: the reference gives guidance on how to make peptide libraries on solid supports, thus it would be obvious to one skilled in the art to make peptide libraries and use the libraries in further manipulations. Baindur et al teach active peptide identified (can be from a peptide library) through bioassay screening and can be optimized by synthesizing a large number of analogs by combinatorial parallel robotic synthesis. The reference further teaches that the active peptide that binds to the target is identified, and the active peptide is optimized synthesizing a large number of analogs, which method requires that the amino acid sequence of the active peptide is determined. Thus, the rejections of record have been maintained.

Applicants arguments regarding the 'Hirshmann et al' reference have been considered. Applicants argue that Hirshmann et al teach four steroid mimetics which would not read on the instant claim non-peptide library. Applicants arguments have been considered and is not persuasive, since the reference teaches 'design and synthesis of steroidal peptidomimetics, and mimics of peptides (refers to the peptide mimetics of the instant claims) are attached to the steroidal scaffold, which are designed based on the peptides which bind to the fibrinogen receptor (refers to the peptide), and the reference teaches at least steroid-peptide mimetics which refer to the library. Thus, applicants arguments are not persuasive. Applicants arguments are based on individual or single references whereas the rejection was based on combined teachings of Hirshmann et al and Blake et al. Blake et al teach methods of 'peptide library synthesis.' Thus it would have been obvious to one skilled in the art at the time the invention was made to use the peptides synthesized by the method taught by Blake et al and use the peptide as a model to design the peptide mimetics as taught by Hirshmann et al.

And further applicants argue unexpected results, which are not present in the claims and further it would be obvious to one skilled in the art to obtain different results by optimizing the reaction conditions or reagents of the reference method.

Applicants arguments regarding the rejection of claims over combined teachings of Hirshmann et al, Blake et al and Gordon et al have been considered and are not persuasive, since applicants arguments are based on individual references.

Applicants arguments regarding Hirshmann et al, Blake et al, Stankova et al and Scott et al have been considered and are not persuasive.

The rejections of record have been maintained for the reasons of record.